



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,715	04/21/2006	Simon Walker	P0001US1	6311
53896 7590 08/26/2009 PEAK INNOVATIONS INC. ATTN: IP LEGAL DEPARTMENT 203 - 11782 HAMMERSMITH WAY RICHMOND, BC V7A-5E2 CANADA			EXAMINER GARCIA, ERNESTO	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 08/26/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,715

**Applicant(s)**

WALKER, SIMON

**Examiner**

ERNESTO GARCIA

**Art Unit**

3679

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 10 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 21 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 1/4/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election of Species***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

I. Figure 7

II. Figure 8

Note that Figures 1-6, 9, and 10 are generic figures to both species.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claim 8 corresponds to species I.  
Claim 10 corresponds to species II.

The following claim(s) are generic: claims 1-7, 9, and 11-15 are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

an assessment of the prior art with respect to the independent claims provides no unity of invention since the "special technical features", i.e., "said first and second elongated cross member comprises connector means" common in each of the species is known from patents . Applicant should note that the lack of unity is based on a posteriori and the special technical features, common to all species, do not define a contribution over the prior. See MPEP 1850.

During a telephone conversation with Mr. Mark Hopkinson on August 17, 2009 a provisional election was made without traverse to prosecute the invention of species I, Figures 7, claims 1-9 and 11-15. Confirmation of this election must be made by applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "10" has been used to designate both a picket and railing

system with a first configuration (Figure 1) and another picket and railing system with a second configuration (Figures 4 and 10).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "20" has been used to designate a spacer with a first configuration (Figures 1 and 2), a spacer with a second configuration (Figure 3), a spacer with a third configuration (Figures 4, 5, and 10), a spacer with a third configuration (Figure 6), a spacer with a fourth configuration (Figure 7), a spacer with a fourth configuration (Figure 8), and another spacer with fifth configuration (Figure 9).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "30" has been used to designate an ornamental member with a first configuration (Figure 2), and another ornamental member with a second configuration (Figure 3).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "22" (Figures 2 and 3) and "36" (Figure 5-7) have both been used to designate the spacer member.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "32" (Figure 2) and "52" (Figure 5-8) have both been used to designate the same wing.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "34" (Figure 2) and "54" (Figure 5-8) have both been used to designate the same wing.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "28" (Figure 2) and "42" (Figure 5-8) have both been used to designate the same wall.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "26" (Figure 2) and "40" (Figure 5-8) have both been used to designate the same side.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "24" (Figure 2) and "38" (Figures 5-8) have both been used to designate the same side.

The drawings are objected to because reference characters "30" in Figures 2 and 3, "44", "46", and "56" in Figures 5-7, "42", "44", and "48" in Figure 8, and "62" and "64" in Figure 9, should rather contain a lead line. See 37 CFR 1.84(q). The lead line of reference character "56" in Figures 5 and 6 should not contain an arrow. See 37 CFR 1.84(r).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 3, 7, and 11 are objected to because of the following informalities:  
regarding claim 3, "is a diamond" in line 1-2 should be --comprises a diamond shape--; and,

regarding claims 7 and 11, "the" in line 3 should be deleted as no pickets have been previously set forth. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsen, CA-2,387,296.

Regarding claim 1, Larsen discloses, in Figures 8A and 8B, an ornamental picket spacer comprising an elongated spacer member **56** and an ornamental member **66**. The elongated spacer member **56** has generally parallel sides **A1** (see marked-up attachment) and a wall **A2** extending therebetween. The ornamental member is connected to the wall **A2**.

Regarding claim 2, the generally parallel sides **A1** comprise wings **A1**.



Regarding claim 4, the ornamental member **66** is a circle.

Regarding claim 13, Larsen discloses, in Figures 8A and 8B, a kit comprising an elongated spacer member **56** and an ornamental member **66**. The elongated spacer member **56** has generally parallel sides **A1** and a wall **A2** extending therebetween. Note that the ornamental member is able to be connected to the wall **A2**.

Regarding claim 15, Larsen discloses, in Figures 8A and 8B, an ornamental picket spacer comprising an elongated spacer member **56** and an ornamental member **66** connected to the elongated spacer member **56**.

Claims 1, 2, 5-7, 9, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Igarashi, JP-1-310073.

Regarding claim 1, Igarashi discloses, in Figures 3A and 3B, an ornamental picket spacer comprising an elongated spacer member **6a** and an ornamental member **6c**. The elongated spacer member **6a** has generally parallel sides (vertical walls) and a wall (the horizontal wall) extending therebetween. The ornamental member is connected to the wall (the horizontal wall).

Regarding claims 2 and 6, the parallel sides (the vertical walls) comprise wings (note that the horizontal wall extends beyond the sides).

Regarding claim 5, the spacer further comprises an elongated cross member **6b** connected to the ornamental member **6c** and disposed generally parallel to the spacer member and generally in the same plane as the elongated spacer member **6a**. The elongated cross member **6c** has a first end and a second end (opposite ends).

Regarding claim 7, the first and second ends of the elongated cross member **6c** comprises connector means (the vertical wall of each end of the cross member) for connecting the elongated cross member to pickets.

Regarding claim 9, the connector means comprises connector walls (end face at each end of the cross member constitutes a connector wall) extending generally perpendicular to the cross member **6c**.

Regarding claim 13, Igarashi discloses, in Figures 3A and 3B, a kit comprising an elongated spacer member **6a** and an ornamental member **6c**. The elongated spacer member **6a** has generally parallel sides (the vertical walls) and a wall (the horizontal wall) extending therebetween. Note that the ornamental member is able to be connected to the wall (the horizontal wall).

Regarding claim 14, the kit further comprises an elongated cross member **6b** connected to the ornamental member **6c** and disposed generally parallel to the spacer

member and generally in the same plane as the elongated spacer member **6a**. The elongated cross member **6c** has a first end and a second end (opposite ends).

Regarding claim 15, Larsen discloses, in Figures 8A and 8B, an ornamental picket spacer comprising an elongated spacer member **6a** and an ornamental member **6c** connected to the elongated spacer member **6a**.

Claims 1, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Edgman, 5,702,090.

Regarding claim 1, Edgman discloses, in Figures 2 and 7, an ornamental picket spacer comprising an elongated spacer member **22** and an ornamental member **58**. The elongated spacer member **22** has generally parallel sides **148**, **150** (see Figure 7; upside-down) and a wall **154** (see Figure 7; upside-down) extending therebetween. The ornamental member **58** is connected to the wall **154**.

Regarding claim 5, the spacer further comprises an elongated cross member **24** connected to the ornamental member **58** and disposed generally parallel to the elongated spacer member **22** and generally in the same plane as the elongated spacer member **22**. The elongated cross member **24** has a first end and a second end.

Regarding claim 7, the first and second ends of the elongated cross member **24** comprises a connector means **40** for connecting the elongated cross member.

Regarding claim 8, the connector means **40** comprises tines **92, 94** spaced apart.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen, CA-2,387,296.

Regarding claim 3, Larsen, as discussed, fails to disclose the ornamental member being a diamond. However, Larsen suggests that the ornamental member can have other designs (page 15, line 17). Therefore, one skilled in the art would have changed the shape into a diamond shape or any other shape as may be desired for a particular application so as to achieve the desired aesthetic appearance. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the ornamental member into a diamond shape for aesthetic purposes.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi, JP-1-310073 in view of Larsen, CA-2,387,296.

Regarding claim 11, Igarashi, as disclosed, fails to disclose the ornamental member having a diamond shape. Applicant is reminded that it has been consistently held that changing the shape of the ornamental member for aesthetic purposes is well-within the expected level of skill of one of ordinary skill in the art. One skilled in the art would have changed the shape into a diamond shape, or any other shape, as a matter of ornamental preference. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the ornamental member of Igarashi into a diamond shape in view of Larsen so as to achieve the desired aesthetic appearance.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi, JP-1-310073 in view of Preston, D195,033.

Regarding claim 12, Igarashi, as disclosed, fails to disclose the ornamental member having a circle shape. Preston teaches, in Figures 1 and 2, an ornamental member having a circle shape to provide a fence with an aesthetic appeal other than a cross shape. Therefore, as taught by Preston, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the ornamental member of Igarashi with a circle shape to provide a different aesthetic appeal.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3679

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

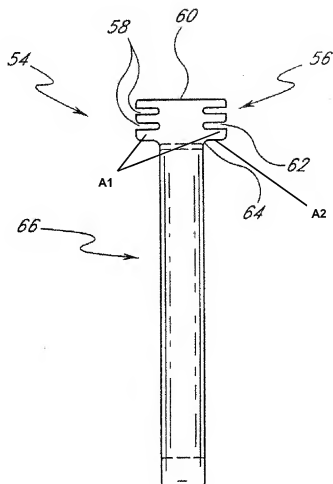
/E. G./

Examiner, Art Unit 3679

August 26, 2009

Attachment: one marked-up page Larsen, CA-2,387,296.

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679



**FIG. 8B**